

DOCKET NO: 264704US0PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
OLEG STENZEL, ET AL. : EXAMINER: SMITH, J.
SERIAL NO: 10/522,672 :
FILED: AUGUST 16, 2005 : GROUP ART UNIT: 1793
FOR: PRECIPITATED SILICA WITH :
HIGH SURFACE AREA

REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

The following Reply Brief is in reply to the Examiner's Answer dated August 4, 2009 (Answer).

The statement of the Grounds of Rejection (Answer at 3-4) is identical to the statement in the Final Rejection, except that the statement does not list Claim 20. Rather, the Examiner discusses Claim 20 in a Response to Argument (Answer at 9-10). The Grounds of Rejection have already been responded to in the Second Appeal Brief. The following is in reply to the Response to Argument (Answer at 4-10).

Regarding Applicants' argument that Uhrlandt et al is significantly broader than the present claims and that all of the examples of Uhrlandt et al are outside the terms of the present claims, the Examiner simply repeats part of the statement of the Grounds of Rejection from page 3 of the Answer, and adds material regarding Sears number that was omitted from the statement of the Grounds of Rejection but was in the Final Rejection (Answer at 5). Thus, the Second Appeal Brief has already responded to this finding.

The Examiner cites precedent to the effect that a patent as prior art is not limited to its examples or preferred embodiments but for all relevant information which it may contain (Answer at 6). The Examiner continues that one of ordinary skill in the art “could have reasonably selected and optimized the claimed properties from the prior art to make the instant invention” (*Id.*) The Examiner also finds that the presently-recited ranges are overlapping with and/or encompassed by Uhrlandt et al in response to Applicants’ argument that the present claims cover, in effect, only a very small and narrow part of the disclosure of Uhrlandt et al (Answer at 7).

In reply, the Examiner’s position proscribes any possibility of demonstrating patentability for a sub-genus invention over a genus disclosed in the prior art. Indeed, that is not the law. See, for example, *In re Woodruff*, 919 F.2d 1575, 16 USPQ 2d 1934 (Fed. Cir. 1990).

In addition, as Applicants previously pointed out in the Second Appeal Brief, Uhrlandt et al is directed to improving dispersibility of precipitated silica in rubber mixtures. Accordingly, Applicants do not question that one of ordinary skill in the art would have been able to optimize the parameters of the precipitated silica of Uhrlandt et al to optimize such dispersibility. But since Uhrlandt et al discloses and suggests nothing with regard to the sub-genus of tires intended for commercial vehicles such as trucks, motor bikes, and high-speed automobile tires, or the particular properties that such tires need to have for satisfactory performance, it clearly would not have been obvious to optimize these parameters, i.e., BET surface area, CTAB surface area, Sears number, etc., for these properties, without the present disclosure as a guide.

Regarding Applicants’ argument that the presently-claimed silicas are intended for commercial vehicle tires, which tires have a requirements profile different from that of

passenger car tires, the Examiner repeats the finding that the claims are drawn to a silica, not to tires (Answer at 6-7).

In reply, Applicants have already responded to this finding in the Second Appeal Brief, which response is still maintained.

In response to Applicants' arguments about the data presented in the Wehmeier Declaration, the Examiner finds that the examples of Uhrlandt et al cannot be compared to the present invention "because none of the examples of Uhrlandt et al. have all the parameters within the instantly claimed ranges" (Answer at 7-8).

In reply, Applicants have compared to a representative example of Uhrlandt et al. The Examiner's rationale appears to be that Applicants should have compared the present invention to the present invention! See *In re Chapman*, 357 F.2d 418, 148 USPQ 711 (CCPA 1966) (requiring Applicant to compare claimed invention with polymer suggested by the combination of references relied upon in the rejection of the claimed invention under 35 U.S.C. § 103 "would be requiring comparison of the results of the invention with the results of the invention." 148 USPQ at 714).

The Examiner further finds that the dynamic modulus, tensile strength and other characteristics demonstrated in the Wehmeier Declaration are not claimed (Answer at 8).

In reply, this argument has already been responded to in the Second Appeal Brief.

In response to Applicants' separate argument for patentability of Claim 20, the Examiner continues to find that the respective Sears numbers of the presently-claimed invention and Uhrlandt et al overlap when both are calculated the same way (Answer at 9-10).

In reply, Applicants have already explained in the Second Appeal Brief that the Sears number of the present invention and that of Uhrlandt et al are drawn to the same parameter, i.e., are already calculated the same way. Therefore, Applicants continue to maintain that

Application No. 10/522,672
Reply Brief

there is no overlap and that Uhrlandt et al neither discloses nor suggests a Search number greater than 25.

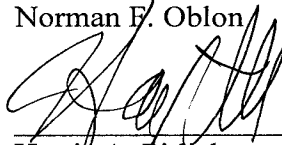
Applicants continue to maintain that all of the remaining rejections should be REVERSED.

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